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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,646	07/15/2003	Simon Piers Robinson	55096-AA/JPW/GJG	9124

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EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/619,646

Applicant(s)

ROBINSON, SIMON PIERS

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 35-56 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 5/16/06
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**SUPPLEMENTAL ACTION**

**Restriction/Election**

1. Upon reconsidering the Preliminary Amendment and telephonic interview on May 16, 2006 with the Attorney of the record (See Interview Summary), the Previous office action is vacated herein and the claims 34-55 are subjected to a restriction requirement as set forth below.
2. Examiner notes that the original claims are 1-34, however, the Preliminary amendment filed on 7/15/2003 indicates cancellation of the claims 1-33 and add new claims 34-55. For restriction purpose examiner rennumbers the new claims as 35-56, since the original claims are 1-34.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 35-42, 56, drawn to a nucleic acid, vector and host cell, requiring SEQ ID Nos. 1-30, classified in class 536, subclass 23.1, 24.33, class 435, subclass 320.1.
  - II. Claims 45-46, drawn to a method of increasing / decreasing the level of PPO activity, requiring SEQ ID Nos. 1-30, classified in class 435, subclass 6.
  - III. Claims 43-44, drawn to a transformed plant, requiring SEQ ID Nos. 1-30, classified in class 800, subclass 278.
  - IV. Claims 47-55, drawn to a method for isolating a nucleic acid molecule, requiring SEQ ID Nos. 1-30, classified in class 435, subclass 91.21.
4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case the product (nucleic acid) of Group I can be used to in materially different processes such nucleic acid purification or labeling assays as opposed to its use in modulating the PPO activity in plants.

Searching the inventions of Groups I and II together would impose serious search burden. The inventions of Groups I and II have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the method of increasing / decreasing the level of PPO activity, and the product are not coextensive. Group II encompasses method steps for the method of increasing / decreasing the level of PPO activity, which are not required for the search of Group I. In contrast, the search for Group I would require a text search for the use of the product (nucleic acid) in addition to a search for the product itself. Prior art, which teaches the product, would not necessarily be applicable to the method of increasing / decreasing the level of PPO activity. Moreover, even if the product were known, the method of increasing / decreasing the level of PPO activity, may be novel and unobvious in view of the preamble or active steps.

Inventions I, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The nucleic acid (Group I), the transformed plant (Group III), are unrelated as they comprise distinct materials and utilize different processes, which demonstrate that each product has a different mode of operation. Each invention performs this function using a structurally and functionally divergent material. Moreover, the methodology and materials necessary for a nucleic acid of Group I differ significantly from a transformed plant of Group III. Therefore, each product is divergent in

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materials. For these reasons the Inventions I and III are patentably distinct. Furthermore, the distinct products require separate and distinct searches. As such, it would be burdensome to search the inventions of Groups I and III together.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (nucleic acid) of Group I can be used to in materially different processes such nucleic acid purification or labeling assays as opposed to its use in modulating the PPO activity in plants.

Searching the inventions of Groups I and IV together would impose serious search burden. The inventions of Groups I and IV have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the method of isolating a nucleic acid molecule, and the product are not coextensive. Group IV encompasses method steps for the isolating a nucleic acid, which are not required for the search of Group I. In contrast, the search for Group I would require a text search for the use of the product (nucleic acid) in addition to a search for the product itself. Prior art, which teaches the product, would not necessarily be applicable to the method of isolating a nucleic acid, moreover, even if the product were known, the method of isolating a nucleic acid, may be novel and unobvious in view of the preamble or active steps.

Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group III can be used to in materially different processes such as hybridization or nucleic acid isolation assays as opposed to its use as a probe transformed plant.

Searching the inventions of Groups II and III together would impose serious search burden. The inventions of Groups II and III have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the method of increasing / decreasing the level of PPO activity, and the product of Group III are not coextensive. Group II encompasses method steps for method of increasing / decreasing the level of PPO activity, which are not required for the search of Group III. In contrast, the search for Group III would require a text search for the use of product in addition to a search for the product itself. Prior art, which teaches the product, would not necessarily be applicable to the method the method of increasing / decreasing the level of PPO activity. Moreover, even if the product were known, the method of increasing / decreasing the level of PPO activity may be novel and unobvious in view of the preamble or active steps.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The method of increasing / decreasing the level of PPO activity of Group II and the method of isolating a nucleic acid

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molecule are unrelated as they comprise distinct materials and utilize different processes, which demonstrate that each product has a different mode of operation. Each invention performs this function using a structurally and functionally divergent material. Moreover, the methodology and materials necessary for method of Group II differ significantly from the method of Group IV. Therefore, each product is divergent in materials and method steps with different end-results. For these reasons the Inventions II and IV are patentably distinct. Furthermore, the distinct method steps require separate and distinct searches. As such, it would be burdensome to search the inventions of Groups II and IV together.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (nucleic acid) of Group III can be used to in materially different processes such nucleic acid labeling assays as opposed to its use in modulating the PPO activity in plants.

Searching the inventions of Groups III and IV together would impose serious search burden. The inventions of Groups III and IV have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the method of isolating a nucleic acid, and the product are not coextensive. Group IV encompasses method steps for isolating a nucleic acid,, which are not required for the search of Group III. In contrast, the search for Group III would require a text search for the use of the product (transformed plant) in addition to a search for the product itself. Prior art, which teaches the product, would not necessarily be

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applicable to the method of isolating a nucleic acid, moreover, even if the product were known, the method of isolating a nucleic acid, may be novel and unobvious in view of the preamble or active steps.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

5. Additionally, the inventions above are subjected to further restriction. Applicant is required to specify one nucleic acid sequence (SEQ ID NO.) for examination. This requirement is made under 1192 O.G. 68 Notice (November 19, 1996), as the examination of more than one sequence in the application would result in an undue search burden on the PTO, further each sequence is patentable distinct because these sequences have different structural and chemical characteristics. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141. By statute, “[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.” 35 U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant... to elect that invention to which his claim shall be restricted.” 37 CFR 1.142 (a). See also 37 CFR 1.141(a).



6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M , Mon - Friday,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/19/06